

The opinion in support of the decision being entered today was not written  
for publication and is not binding precedent of the Board.

Paper No. 37

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Ex parte GERD BRANDHORST, WOLF-DIETRICH HEROLD

and

RALF HEIDUCZEK

**MAILED**

SEP 08 2005

U.S. PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Appeal No. 2005-1900  
Application No. 09/368,505<sup>1</sup>

ON BRIEF<sup>2</sup>

Before FRANKFORT, NASE, and PAWLICKOWSKI, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

**REMAND**

This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective

September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office

<sup>1</sup> Application filed August 5, 1999, for reissue of U.S. Patent No. 5,653,360 (Application No. 08/574,697, filed December 19, 1995), which is a continuation of Application No. 08/371,219, filed January 11, 1995, now U.S. Patent No. 5,501,368.

<sup>2</sup> The hearing scheduled for September 13, 2005 has been postponed in view of this remand to the examiner for further action.

21 (September 7, 2004)) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

#### THE REJECTION UNDER APPEAL

Claims 11 to 38 stand rejected under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.<sup>3</sup> The basis advanced by the examiner for this rejection is as follows (answer (mailed August 4, 2003), p. 3):

A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The supporting surface is part of the structure used to define the "gap" or "play" and it is this limitation that cannot be removed from the claims. The new claims submitted in the reissue do not define the "gap" or "play" in this manner. The definition of the gap cannot be broadened since it is the portion of the claim that was put in the independent claims to make them allowable.

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<sup>3</sup> Claims 1 to 10, the only other claims pending in this application, have been allowed.

RECAPTURE UNDER 35 U.S.C. § 251

The reissue statute expressly permits a patentee to obtain reissue claims broader than the original issued claims at anytime within two years from the date the original patent issues. 35 U.S.C. § 251.<sup>4</sup> The scope of permissible broadened reissue claims is limited by a judicial doctrine known as the "recapture rule." The "recapture rule" was developed to prohibit a patentee from obtaining by reissue broadened claims that "recapture" subject matter the patentee "deliberately surrendered" during the course of the original prosecution to obtain the patent. When an applicant cancels or amends a claim to overcome a prior art rejection, and then relies on the changes made to the claim in arguing patentability of the amended claim, the law infers that the patent applicant admits that prior art forecloses the scope of the original claim. As a result of this inferred admission, competitors are free to practice the subject matter surrendered by the patentee through the cancellation or amendment. To preserve the public notice function of the file history, the "recapture rule" precludes the patentee from recanting its admission that the prior art precluded a certain breadth of claim scope.

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<sup>4</sup> 35 U.S.C. § 251, ¶ 1, provides in pertinent part:  
Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall . . . reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent.

35 U.S.C. § 251, ¶ 4, provides:  
No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

A precedential opinion concerning a reissue recapture rejection under 35 U.S.C. § 251 was entered May 29, 2003 in Ex parte Eggert, 67 USPQ2d 1716 (Bd. Pat. App. & Int. 2003). In Eggert, the majority opinion applied the fact-specific analysis set forth in In re Clement, 131 F.3d 1464, 1468-71 45 USPQ2d 1161, 1164-66 (Fed. Cir. 1997), determined that under the facts and circumstances before it, the "surrendered subject matter" was claim 1 of Eggert as that claim existed prior to the post-final rejection amendment that led to the allowance of claim 1 in the original patent, and decided that reissue claims 15-22 of Eggert were not precluded (i.e., barred) by the "recapture rule." 67 USPQ2d at 1730-33.

The court in In re Clement, 131 F.3d at 1468-70, 45 USPQ2d at 1163-65 stated that:

An attorney's failure to appreciate the full scope of the invention qualifies as an error under section 251 and is correctable by reissue. In re Wilder, 736 F.2d 1516, 1519, 222 USPQ 369, 370-71 (Fed. Cir. 1984). Nevertheless, "deliberate withdrawal or amendment . . . cannot be said to involve the inadvertence or mistake contemplated by 35 U.S.C. § 251." Haliczer v. United States, 356 F.2d 541, 545, 148 USPQ 565, 569 (Ct. Cl. 1966). The recapture rule, therefore, prevents a patentee from regaining through reissue the subject matter that he surrendered in an effort to obtain allowance of the original claims. See Mentor, 998 F.2d at 995, 27 USPQ2d at 1524. Under this rule, claims that are "broader than the original patent claims in a manner directly pertinent to the subject matter surrendered during prosecution" are impermissible. Id. at 996, 27 USPQ2d at 1525.

The first step in applying the recapture rule is to determine whether and in what "aspect" the reissue claims are broader than the patent claims. For

example, a reissue claim that deletes a limitation or element from the patent claims is broader in that limitation's aspect. Clement argues that the board focused too much on the specific limitations that were omitted from the reissue claims. Although the scope of the claims is the proper inquiry, In re Richman, 409 F.2d 269, 274, 161 USPQ 359, 362 (CCPA 1969), claim language, including limitations, defines claim scope. Abtox, Inc. v. Exitron Corp., 122 F.3d 1019, 1023, 43 USPQ2d 1545, 1548 (Fed. Cir. 1997); Bell Communications Research, Inc. v. Vitalink Communications Corp., 55 F.3d 615, 619, 34 USPQ2d 1816, 1819 (Fed. Cir. 1995) ("[T]he language of the claim defines the scope of the protected invention."). Under Mentor, courts must determine in which aspects the reissue claim is broader, which includes broadening as a result of an omitted limitation. The board did not err by determining which limitations Clement deleted from the patent claims.

The second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. To determine whether an applicant surrendered particular subject matter, we look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection. See Mentor, 998 F.2d at 995-96, 27 USPQ2d at 1524-25; Ball Corp. v. United States, 729 F.2d 1429, 1436, 221 USPQ 289, 294-95 (Fed. Cir. 1984).

Although the recapture rule does not apply in the absence of evidence that the applicant's amendment was "an admission that the scope of that claim was not in fact patentable," Seattle Box Co. v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984), "the court may draw inferences from changes in claim scope when other reliable evidence of the patentee's intent is not available," Ball, 729 F.2d at 1436, 221 USPQ at 294. Deliberately canceling or amending a claim in an effort to overcome a reference strongly suggests that the applicant admits that the scope of the claim before the cancellation or amendment is unpatentable, but it is not dispositive because other evidence in the prosecution history may indicate the contrary. . . . Amending a claim "by the inclusion of an additional limitation [has] exactly the same effect as if the claim as originally presented had been canceled and replaced by a new claim including that limitation." In re Byers, 230 F.2d 451, 455, 109 USPQ 53, 55 (CCPA 1956).

Once we determine that an applicant has surrendered the subject matter of the canceled or amended claim, we then determine whether the surrendered

subject matter has crept into the reissue claim. Comparing the reissue claim with the canceled claim is one way to do this. In re Wadlinger, 496 F.2d 1200, 1204, 181 USPQ 826, 830 (CCPA 1974); Richman, 409 F.2d at 274, 161 USPQ at 362. If the scope of the reissue claim is the same as or broader than that of the canceled claim, then the patentee is clearly attempting to recapture surrendered subject matter and the reissue claim is, therefore, unallowable. Ball, 729 F.2d at 1436, 221 USPQ at 295 ("The recapture rule bars the patentee from acquiring, through reissue, claims that are the same or of broader scope than those claims that were canceled from the original application.") (emphasis omitted); Byers, 230 F.2d at 456, 109 USPQ at 56. In contrast, a reissue claim narrower in scope escapes the recapture rule entirely. Ball, 729 F.2d at 1436, 221 USPQ at 295.

Some reissue claims, however, are broader than the canceled claim in some aspects, but narrower in others. In Mentor, for example, the issued claim, which was directed to a condom catheter, recited an adhesive means that was transferred from an outer to an inner surface without turning the condom inside-out. 998 F.2d at 993, 27 USPQ2d at 1523. The issued claim also recited, inter alia, that the condom catheter included a "thin cylindrical sheath member of resilient material rolled outwardly upon itself to form consecutively larger rolls . . ." One canceled claim recited an adhesive means between the rolls, but did not specify that the adhesive was transferred from the outer to the inner surface without turning the condom inside-out. Another canceled claim recited that adhesive was transferred from the outer to the inner surface, but did not specify that this operation was done without turning the condom inside-out. The prior art rejections focused on the obviousness of the adhesive means positioned between the rolls and the process of transferring adhesive to the inner surface of the condom.

In making amendments to the claim, the applicant argued that "none of the references relied upon actually showed the transfer of adhesive from the outer surface to the inner surface as the sheath is rolled up and then unrolled." Id. at 995-96, 27 USPQ2d at 1524-25 (emphasis omitted). The reissue claim eliminated the limitation that adhesive was transferred from the outer to the inner layer, and was, therefore, broader in this aspect. The reissue claim was also narrower than the canceled claim because it recited that the catheter included "a thin, flexible cylindrical member of resilient material rolled outwardly upon itself to form a single roll. ..." (Emphasis omitted). We held that, although the "flexible" and "single roll" limitations made the reissue claim narrower than both the canceled and issued claims, it did not escape the recapture rule because these

limitations did not "materially narrow the claim [ ]." *Id.* at 996-97, 27 USPQ2d at 1525-26.

Similarly, in Ball, the issued claim recited "a plurality of feedlines" and a "substantially cylindrical conductor." 729 F.2d at 1432-33, 221 USPQ at 291-92. The canceled claim recited "feed means includ[ing] at least one conductive lead," and a "substantially cylindrical conductor." The prosecution history showed that the patentee added the "plurality of feedlines" limitation in an effort to overcome prior art, but the cylindrical configuration limitation was neither added in an effort to overcome a prior art rejection, nor argued to distinguish the claims from a reference. *Id.* The reissue claim included limitations not present in the canceled claims that related to the feed means element, but allowed for multiple feedlines. On balance, the claim was narrower than the canceled claim with respect to the feed means aspect. The reissue claim also deleted the cylindrical configuration limitation, which made the claim broader with respect to the configuration of the conductor. *Id.* at 1437, 221 USPQ at 295. We allowed the reissue claim because the patentee was not attempting to recapture surrendered subject matter. *Id.* at 1438, 221 USPQ at 296.

In both Mentor and Ball, the relevance of the prior art rejection to the aspects narrowed in the reissue claim was an important factor in our analysis. From the results and reasoning of those cases, the following principles flow: (1) if the reissue claim is as broad as or broader than the canceled or amended claim in all aspects, the recapture rule bars the claim; (2) if it is narrower in all aspects, the recapture rule does not apply, but other rejections are possible; (3) if the reissue claim is broader in some aspects, but narrower in others, then: (a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; (b) if the reissue claim is narrower in an aspect germane to prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible. Mentor is an example of (3)(a); Ball is an example of (3)(b).

The Federal Circuit in Clement thus set forth the following analytical process for determining if the recapture rule should be applied against claims in a reissue application.

The first step in applying the recapture rule is to determine whether and in what "aspect" each reissue claim is broader than the patent claims.

The second step is to determine whether the broader aspects of each reissue claim relates to surrendered subject matter. Thus, one looks to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection to determine what surrendered subject matter<sup>5</sup> exists, if any. If no surrendered subject matter exists, then the "recapture rule" does not apply. If surrendered subject matter exists, it must then be determined whether the surrendered subject matter has crept into any reissue claim. Accordingly, each reissue claim must be compared with the surrendered subject matter.<sup>6</sup> If the scope of a reissue claim is as broad as or broader than the surrendered subject matter in all aspects, then the recapture rule bars

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<sup>5</sup> In Hester Indus. Inc. v. Stein Inc., 142 F.3d 1472, 1482, 46 USPQ2d 1641, 1649 (Fed. Cir. 1998), the Federal Circuit determined that surrendered subject matter can occur through arguments alone.

<sup>6</sup> Surrendered subject matter is either (1) the claim deliberately canceled or amended in an effort to overcome a prior art rejection (which strongly suggests that the applicant admits that the scope of the claim before the cancellation or amendment is unpatentable); or (2) the argued claim minus the argued limitations when surrendered subject matter occurs through arguments alone as in Hester.

that claim. In contrast, a reissue claim narrower in scope than the surrendered subject matter in all aspects (i.e., a claim that has not been broaden in any aspect relative to the surrendered subject matter and has been amended to be narrower than the surrendered subject matter in at least one aspect) escapes the recapture rule entirely. However, if a reissue claim is broader than the surrendered subject matter in at least one aspect, but narrower than the surrendered subject matter in at least other aspect, then the broadening aspects of the reissue claim must be balanced against the narrowing aspects of the reissue claim to determine if the recapture rule bars the claim.<sup>7</sup>

#### ACTION

In the recapture rejection before us in this appeal, the examiner has not compared the subject matter of each of claims 11 to 38 to the "surrendered subject matter." Instead, the examiner has compared claims 11 to 38 to the allowed claims that

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<sup>7</sup> See Clement; Mentor; Ball; and Eggert. In Pannu v. Storz Instruments Inc., 258 F.3d 1366, 1370-71, 59 USPQ2d 1597, 1600 (Fed. Cir. 2001), the court followed the analytical process of Clement and found that the "recapture rule" applied. In North American Container, Inc. v. Plastipak Packaging, Inc., et al., 415 F.3d 1335, 1349-50, 75 USPQ2d 1545, 1556-57 (Fed. Cir. 2005), the court again followed the analytical process of Clement and found that the "recapture rule" applied.

issued in U.S. Patent Nos. 5,653,360 and 5,501,368.<sup>8</sup> As such, the examiner has not set forth a prima facie case to support a recapture rejection of each of claims 11 to 38.

We remand this application to the examiner to determine whether a recapture rejection of any of claims 11 to 38 under 35 U.S.C. § 251 is appropriate. In making this determination, the examiner must follow the analytical process established by In re Clement, 131 F.3d at 1468-71 45 USPQ2d at 164-66 for each claim. The first step is to determine whether and in what aspect each reissue claim (i.e., each of claims 11 to 38) is broader than the patent claims. The second step is to determine whether each broader aspect, if any, of each reissue claim relates to surrendered subject matter.

While the examiner performed the first step, the examiner has not performed the second step. To perform the second step the examiner must determine what subject matter constitutes "surrendered subject matter." "Surrendered subject matter" is subject matter that applicant has admitted was not patentable over the prior art such as by deliberately canceling or amending a claim to overcome prior art.<sup>9</sup> If the reissue

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<sup>8</sup> We note that the subject matter of original claim 3 in Application No. 08/371,219 was never subject to any rejection and thus is not part of the surrendered subject matter.

<sup>9</sup> Clearly, claims 1 and 2 as originally presented in Application No. 08/371,219 constitute surrendered subject matter since these claims were subject to a prior art rejection and later canceled to overcome that prior art rejection.

claim is as broad as or broader than the canceled or amended claim [the surrendered subject matter] in all aspects, the recapture rule bars the claim. If it is narrower than the canceled or amended claim [the surrendered subject matter] in all aspects, the recapture rule does not apply. If the reissue claim is broader than the canceled or amended claim [the surrendered subject matter] in some aspects, but narrower than the canceled or amended claim [the surrendered subject matter] in other aspects, then the examiner must determine if each broadening aspect or narrowing aspect is or is not germane to a prior art rejection, then the examiner must balance the narrowing aspects against the broadening aspects to determine if the recapture rule bars each claim. Id.

#### CONCLUSION

The application has been remanded to the examiner for further consideration as set forth above.

This application, by virtue of its "special" status, requires immediate action, see  
MPEP § 708.01.

REMANDED



CHARLES E. FRANKFORT  
Administrative Patent Judge

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